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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,278	12/20/2001	Yvette L. Hammonds	17,705	6832

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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/037,278	Applicant(s) HAMMONDS ET AL.	
	Examiner Karin M. Reichle	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 17-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-6-06 has been entered.

Specification

Drawings

2. The drawings were received on 1-6-06. Figures 1F and 2A-2D are approved by the Examiner. With regard to the microphotographs, as set forth in MPEP 608.02, photographs are not ordinarily permitted in utility patents. The PTO will accept such if they are the only practicable medium for illustrating the claimed invention. Applicant's remarks on page 9 of the 1-6-06 response have been noted but do not set forth why photomicrographs are the only practicable medium in the instant case, i.e. the remarks only set forth that such offer a better understanding of the invention as compared to drawings. Therefore, such photographs are not approved, see discussion infra

3. The drawings are objected to because in Figures 5A-7, the descriptive text should be avoided and for the reasons discussed supra, drawings should be submitted in lieu of the photographs (Also note at, e.g., page 6, lines 15-16 and pages 14-15 referring to

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photomicrographs). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Language Interpretation

4. The claim terminology is interpreted in light of the definition on page 6, lines 20-30. Lines 9-15 of claim 1 are interpreted to require a pair of first fastener components one of each being positioned on one of each of the wings both on one of the first and second surfaces and a pair of cooperating fastener components one of each being positioned on one of each of the wings both on the other of the first and second surfaces. This also applies to like language in the other independent claims 17 and 27. Claims 17 and 27 further require the one surface to be the bottom or lower surface. Claim 28 requires the same but fasteners on each wing on opposite

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surfaces but not necessarily the same surfaces as the other wing. It is further noted that claims 17, 27 and 28 do not require the unengaged first fastener be capable of engaging fabric of the garment and the claimed garment is not required to be only fabric.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-9 and 17-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hammons et al '484.

In regard to claims 1-9 and 17-28, see Figures 1-10, especially Figures 7-10, i.e. the topsheet is 22, the backsheet is at least 26, the core is 24, the adhesive and the peel strip are 58-59, the first and second wings are 34, 36, see also paragraphs 84-87 of Hammons et al, i.e. can be of liquid permeable material or liquid impermeable material, the fastener components are 102, 104, see also paragraphs 88-99, 107 and 108, and thereby Scripps '724 at col. 12, lines 36-42, and thereby Noel et al '520 at, e.g., Figures, col. 6, lines 48-51 and col. 8, lines 3-9, i.e. nonwoven pattern unbonded loop material. See also Figures 6-8 and paragraphs 121-123, i.e. the fastener component is the one fastener 102, 104 directly adjacent exterior of the undergarment. It is noted that both components, i.e. the hooks and loops, include engagement members, see page 12, lines 11-12 of the instant specification. The last two subsections of claims 1, 17, and 27 and lines 7 and 10-11 of claim 28 recite capabilities, function or properties of the claimed structure. The Hammons et al device includes all the claimed structure. Therefore there is sufficient factual basis for one to conclude that the capabilities, functions and properties of such

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claimed structure is also inherent in the same structure of Hammons et al, see MPEP 2112.01.

Note also the Response to arguments section *infra*.

In regard to claims 2-3, and 19-21, also note Figure 11, and paragraph 123.

In regard to claims 6, and 24, see Figures 25-28 and paragraph 142.

In regard to claim 26, see also elements 160 and 161 and paragraphs 160-164.

7. Claims 1, 6-9, 17-18 and 24-28 rejected under 35 U.S.C. 102(b) as being anticipated by Bien '929, and thus Mattingly '047.

With regard to claims 1, 6-9, 17-18 and 24-28, see Figures of Bien, i.e. topsheet is 28, the backsheet is 30, the core is 32, the adhesive and peel strip are 34, 36 and the flaps and fastener components are set forth at col. 7, lines 29-59, and thereby Mattingly '047 at col. 6, line 44-col. 7, line 5, col. 2, lines 17-32 and col. 8, lines 9-41. It is noted that the portions of Mattingly are considered to teach that the cohesive structure in Figure 10 could be adhesive or VELCRO instead, i.e. the fastener component is the one fastener directly adjacent exterior of the undergarment. It is noted that both components, i.e. the hooks and loops of the VELCRO, include engagement members, note page 12, lines 11-12 of the instant specification. The last two subsections of claims 1, 17 and 27 and lines 7 and 10-11 of claim 28 as well as claims 6, 18, 24, and 26 recite capabilities, function or properties of the claimed structure. The Bien reference teaches a device which includes all the claimed structure. Therefore there is sufficient factual basis for one to conclude that the capabilities, functions and properties of such claimed structure is also inherent in the same structure of Bien et al, see MPEP 2112.01. Note also the Response to arguments section *infra*.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 4-5, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bien '929 in view of Leak et al '041.

Applicant claims the cooperating fastener component being of nonwoven loop material and a pattern unbonded material whereas Bien only teaches that such is a loop material. However, see Leak et al, col. 1, lines 40-50 and col. 8, lines 55-59 and abstract. To employ a pattern unbonded nonwoven loop material as taught by Leak et al on the Bien device as the loop material would be obvious to one of ordinary skill in the art in view of the recognition that Bien teaches a situation in which hook and loop fasteners have been employed and that such would also be economically efficient which would be desirable in any disposable article and the article of Bien being disposable. Note also the Response to arguments section infra.

10. Claims 2-3, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bien '929 in view of Osborn III '884.

Applicant claims nonisotropic engagement members oriented orthogonally to the attachment direction which Bien does not teach. Bien does teach the desire to use the flaps to properly position the article in the undergarment. See also Osborn III '884, Figures 44-45 and col. 45, line 67-col. 46, line 1, i.e. hooks oriented in the direction shown in the Figures improves gripping properties. To make the hooks of Bien nonisotropically formed and orthogonally oriented relative to the direction of attachment as taught by Osborn would be obvious to one of ordinary skill in the art in view of the recognition that such would improve gripping, i.e.

securement would be improved which would better insure proper positioning of the article in the undergarment, i.e. accidental loss of securement would lead to improper positioning, and the desirability of proper positioning by Bien. Note also the Response to arguments section infra.

Double Patenting

11. Due to the number of claims under consideration, for the purposes of the following rejections the invention of the claims of the instant application will be considered a sanitary napkin with a pair of wings having selectively releasable interengaging fasteners on opposite surfaces of each wing including a plurality of engagement members which fasteners are capable of fastening the napkin to an undergarment, see, e.g., claim 28. The invention of the '785 patent will be considered to also be a sanitary napkin with a pair of wings having selectively releasable, interengaging fasteners on opposite surfaces of each wing including a plurality of engagement members which fasteners are capable of fastening the napkin to an undergarment but the sanitary napkin additionally includes an garment attachment adhesive and a peel strip and the napkin structure is used in a method which includes fastening the wings over the top of the napkin during removal of the peel strip, positioning the napkin in the undergarment with the adhesive and disengaging the wings from over the napkin to under the napkin and around the undergarment to further secure the napkin in the undergarment, see, e.g., claim 1 of that patent.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.3218 may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-9 and 17-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,843,785. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the effective filing dates of the application and patent is the same, the one way *In re Vogel* test applies, i.e. are the claims of the instant application obvious in view of the patent. The answer is yes. As best understood, see discussion supra in paragraph 11, the claims of the instant application are generic to or broader than the claims of the patent, e.g. doesn't require all the structure and such structure to be used in the method of the patent claim only some of the structure having only the capability of being used, e.g. see e.g. lines 8-9 and last two lines of claim 28. Once an applicant has received a patent for a species or more specific embodiment, he(he) is not entitled to a patent for the generic or broader invention. This is because the specific anticipates the broader. See *In re Goodman*, supra.

Response to Arguments

14. Applicants remarks with regard to the matters of form have been considered but are either deemed moot in that the issue has not been repeated, or deemed not persuasive for the reasons set forth supra. It is noted that Applicant's remarks bridging pages 9-10 did not accurately reflect the Examiner's position with regard to the Figures not showing what was disclosed on pages 9 and 10. Applicants remarks, which are substantially identical to those filed 8-2-04 and 6-16-05, have been reconsidered but are still deemed not persuasive for the same reasons (i.e. Because such are deemed narrower than the prior art rejections, which are not only 103 rejections but also 102 rejections, the teachings of the prior art references and the scope of the claims. Applicant's attention is reinvited to the portions thereof cited supra and the discussion thereof supra. For example, with regard to the Hammonds and Bien references, the Examiner has specifically pointed out where the one of the first fasteners is unengaged with the cooperating fastener and is adapted to engage the undergarment, see, e.g., page 8, lines 2-5 and the last five lines of the 3-16-05 Office action. For another example, the Applicant's remarks in the first full paragraph on page 13 of the 6-16-05 response are narrower than the claim language, i.e. the claims are not method of use claims, the rejection of the claims is under 35 USC 102 and MPEP 2112.01, see page 8, lines 5-9 of the 3-16-05 Office action again. Applicant's remarks with regard to the double patenting rejection have been noted. It is clear that the instant claims are broader than the patent claims because they teach the structure, see paragraph 12 supra, but not the process of use of that structure). In response to Applicant's additional remarks bridging pages 10-11 and page 12, lines 3-13, see, again, e.g., Figures 6-8 and paragraph 121, especially the last sentence thereof, of Hammons. In response to Applicant's additional comment on page

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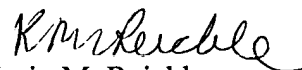
14, lines 8-10, Applicant is again redirected to the prior art rejection supra which points out where Bien teaches the claimed structure and MPEP 2112.01. Applicant's additional comments in the last paragraph on page 16 have been considered but are deemed not persuasive in light of the record of the application which shows no process claims ever having been part thereof nor any restriction requirement rendered.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
January 18, 2006